UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/558,922	04/26/2000	John Albert Kembel	10351-0004	1665

42179   7590   06/27/2006

INNOVATION MANAGEMENT SCIENCES
P. O. BOX 1169
LOS ALTOS, CA 94023-1169

EXAMINER
NGUYEN, CHAU T

ART UNIT	PAPER NUMBER
2176	

DATE MAILED: 06/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>*11 April 2006*</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *32 and 35-43* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *32 and 35-43* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date <u>*01/04/2006*</u>.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   Response to Election/Restriction, filed on 04/11/2006, has been entered. Claims

32 and 35-43 are selected by Jonathan Small (Applicant's representative) via a phone

interview on June 15, 2006.

Election/Restrictions

2.   Applicant's election of claims 32 and 35-43 in group-I with traverse in the reply

filed on 04/11/2004 and the phone interview on June 15, 2006 is acknowledged. The

traversal is on the ground(s) that the subject matter of all claims 32, 35-43 in group I

and claims 44-47 in group II is sufficiently related that the claims of both groups are

directed to "retrieving and transmitting information", each properly falling within the

same class and subclass. This is not found persuasive because of the fact that the

groups I and II may include "retrieving and transmitting information" cannot preclude a

requirement for restriction if their appearances are considered patentably distinct, since

patentably distinct embodiments cannot be supported by a single formal design claim.

In this case, there are two patentably distinct groups of claims, one is drawn to

retrieving and transmitting information including instructions and definition that define a

functionality and an appearance of a user interface and the other is drawn to storing

addresses for content in the data store, which are specifically classified in two different

subclasses 715/744 and 715/530, respectively. Thus, the requirement for restriction is

still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

4.   Claims 32 and 35-43 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Dasan, US Patent No. 5,761,662 and further in view of Furst, US Patent No.

6,297,819.

5.   As to independent claims 32 and 39, Dasan discloses a method of providing

content to a user, comprising:

        receiving a request for the content (Fig. 6 and col. 6, lines 20-37: user can enter

a user name in field 602 and then click on either icons 604, 606 or 610 to request for

content for the specific user name);

        in response to the request, retrieving information usable by a computing device

to present data that is programmed in a format readable by a Web browser program

(Figs. 6&10, col. 3, line 35 – col. 4, line 7, col. 6, lines 38-52 and col. 7, lines 42-60: in

response to the user selection icon 604 in Figure 6, retrieving a user interface for editing a user profile is displayed on screen 1000, and the user interface for editing is supported by a browser); wherein the information includes instructions for invoking a computing device resident process executable and a definition that defines at least in part a functionality and an appearance of a user interface (col. 7, lines 42-60 and Fig. 10) and

transmitting the information (col. 7, lines 42-60).

However, Dasan does not explicitly disclose the format readable a Web browser program outside of a window of a Web browser program, the computing device resident process executable independent of a Web browser and the user interface outside of a window of a Web browser program and within which the results of the computing device resident process are presented. Furst discloses that as is well known, the web browser operates to display in response to user input, web pages in one or more windows (the format readable a Web browser program outside of a window of a Web browser program) (col. 4, lines 22-38). Furst also discloses in col. 4, line 57 – col. 5, line 11 that when the users request the web browser, the client 124 is initiated, the client 124 is a thin shell for an embedded web browser, whose function is to display web pages sent by the System, the System and its component tools operate to create web pages that parallel or shadow actual web pages, which exist outside and independent of the System and its tool. In addition, Furst discloses that the System appears to travel with the users as the user browses the web, and this enables the user to fine at every web site additional functionality that is independent of the web site (col. 2, line 55 – col. 3,

line 6). It would have been obvious to one of ordinary skill in the art at the time the

invention was made to combine the teachings of Furst and Dasan to include the format

readable a Web browser program outside of a window of a Web browser program, the

computing device resident process executable independent of a Web browser and the

user interface outside of a window of a Web browser program and within which the

results of the computing device resident process are presented. Since Furst discloses

that the System appears to travel with the users as the user browses the web, and this

enables the user to fine at every web site additional functionality that is independent of

the web site, thus the System enables users to communicate with other web site visitors

in a context directly relevant to whatever site the user is visiting or the user can have

access to information and services related to, but independent of the control of the web

site the user is visiting.

6.   As to dependent claims 35 and 40, Dasan and Furst (Dasan-Furst) disclose

wherein at least a portion of the user interface is a frame within which the results of the

computing device resident process are presented (Furst, col. 11, lines 55-64: when the

component tool (frame) is activated from the icon bar in a context that includes a fill-in-

web-based form, the tool autofills form with the information. It would have been obvious

to one of ordinary skill in the art at the time the invention was made to combine the

teachings of Furst and Dasan to include at least a portion of the user interface is a

frame within which the results of the computing device resident process are presented

since the component tool operates to create web pages that parallel or shadow actual web pages which exist outside and independent of the component tool).

7.   As to dependent claims 36 and 41, Dasan-Furst disclose wherein at least a portion of the definition fully describes a functionality and an appearance of a frame within which the results of the computing device resident process are presented (Dasan, col. 7, lines 43-60; Furst, col. 2, line 65 – col. 3, line 6, and col. 9, line 9 – col. 12, line 65: each application tool has certain appearance shown by its tool user interface window which is defined by a web page or a wide variety of forms. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Furst and Dasan to include at least a portion of the definition fully describes a functionality and an appearance of a frame within which the results of the computing device resident process are presented. Furst suggests that the component tool can be customized for each user, so users can choose to select and enable only the component tools they find useful).

8.   As to dependent claims 37 and 42, Dasan-Furst disclose wherein the definition is provided by a Web content provider, thereby enabling the Web content provider to control at least in part a functionality and an appearance of the frame when rendered (Dasan, col. 6, lines 11-19 and col. 6, line 61 – col. 7, line 41).

9.   As to dependent claim 38, Dasan-Furst disclose wherein the computing device
resident process is provided by the Web content provider (Dasan, col. 6, line 11 – col. 7,
line 41).

10.   As to dependent claim 43, Dasan-Furst disclose wherein the computing device
resident process, content data, and the definition are provided by the Web content
provider, thereby enabling the user interface to integrate seamlessly with the results of
the computing device resident process and content data (Dasan, col. 6, line 11 – col. 7,
line 41).

Response to Arguments

11.   Applicant's arguments with respect to claims 32 and 35-43 have been considered
but are moot in view of the new ground(s) of rejection using the Furst reference.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chau Nguyen whose telephone number is (571) 272-4092. The Examiner can normally be reached on Monday-Friday from 8:30 am to 5:30 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Heather Herndon, can be reached at (571) 272-4136.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. On July 15, 2005, the Central Facsimile (FAX) Number will change from 703-872-9306 to 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chau Nguyen
Patent Examiner
Art Unit 2176

WILLIAM BASHORE
PRIMARY EXAMINER